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Office of the Director
Group 3600

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In re application of
David T. Frederick, et al.
Application No. 09/086,857
Filed May 29, 1998

For: SYSTEM FOR TRACKING AND
DISPENSING MEDICAL ITEMS FROM
ENVIRONMENTALLY CONTROLLED
STORAGE AREA

: DECISION ON PETITION
: FOR WITHDRAWAL OF
: RESTRICTION REQUIREMENT
: UNDER 37 CFR 1.144

This letter is in response to the petition received on October 10, 2000 under 37 CFR 1.144 to review the propriety of the Restriction Requirement Mailed December 03, 1999. The delay in responding to this petition is regretted.

The petition is **GRANTED**.

Background

A summary of the examiner's Office actions and applicants' responses thereto is listed as follows:

- 1) On December 3, 1999 the examiner sent a Restriction Requirement dividing the application into eight distinct groups.
- 2) On December 30, 1999 applicants submitted an election with traverse accompanied by an amendment in response thereto.

3) On March 14, 2000, the examiner made the restriction final and also sent a non-final rejection.

4) After another amendment from applicants and a final rejection from the examiner applicants then, on October 10, 2000, submitted the petition to withdrawal the restriction requirement.

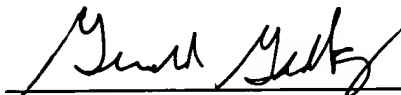
Decision

After a careful review of the application file history it is deemed that the restriction made by the examiner was improper, mainly, for the following reasons: Groups I and II – V do not satisfy the combination/subcombination two-way condition for restriction as asserted by the examiner and required by MPEP 806.05(c). For example, the examiner has not shown that the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and that the subcombination has utility by itself or in other combinations. Keeping this in mind, and looking at group II that includes claims 4-8 and 10-11 drawn to a "rotary locking mechanism", the examiner asserts that this group has utility by itself "such as a stand alone locking mechanism for use on safes, offices..." However, this can not hold true in that claims 4-8 and claims 10-11 all depend from claim 1 and, therefore, include all the features of the "system for providing medical items" as recited in claim 1, and can not "stand alone" to provide a locking mechanism for safes, etc. This reasoning applies to all the combination/subcombination scenarios as asserted by the examiner, which renders all such alleged restrictions improper. Further, the examiner asserts that "invention I is related to inventions VI and VIII as apparatus and processes for practice. For this type of restriction only one way distinctness need be established by either showing "the process as claimed can be practiced by another materially different apparatus or by hand, or the apparatus as claimed can be used to practice another and materially different process, MPEP 806.05(e). In looking at groups I and VI the examiner asserts that "the apparatus or group I may be used to vend beverages" which is completely unreasonable in that the apparatus is specific to a medical dispensing system; therefore, this restriction is improper as are all the apparatus and process for practice type restrictions made by the examiner. It is mainly for these reasons that the entire restriction will be withdrawn and the case sent back to the examiner to examine all the claims.

Thus:

The petition filed October 10, 2000 under 37 CFR 1.144 to review the propriety of the examiner's restriction requirement of December 03, 1999 and request a withdrawal thereof is **GRANTED**.

The application will be sent back to the examiner for examination of all claims 1-47. The finality will be withdrawn. Fees paid for submission of the Notice of Appeal and Appeal Brief will not have to be paid if this application progresses to the appeal stage in the future. However, a new Notice of Appeal and Appeal Brief will be necessary at that time.



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